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10/633,976	08/04/2003	Osamu Suzuki	2271/70770	5636

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EXAMINER

DICKERSON, CHAD S

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2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,976	Applicant(s) SUZUKI, OSAMU	
	Examiner Chad Dickerson	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 10 and 11 are objected to because of the following informalities:
 - Re claim 10: On line 9, the phrase "in the order described" is suggested to be changed to -- in described order --.
 - Re claim 11: On line 16, the phrase "displaying the one-of the" is suggested to be changed to -- displaying one of the --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomida (US Pat No 6922255).

Re claim 1: Tomida '255 discloses an Internet facsimile device, comprising:

image information scanner means (47) for scanning image information of an original and outputting image data (i.e. the scanner (47) is used for reading an image from an original document and the image data is output by using the facsimile device (1)

for transmission through the modem (59); see figs. 1-3; col. 3, lines 57-65 and col. 4, lines 1-60);

display means (57) for displaying information, the display means including a predetermined display unit (i.e. the LCD (57) displays various messages, such as operational procedures and error messages. It also functions as a touch panel; see fig. 2; col. 3, lines 57-65 and col. 4, lines 1-60);

means for transmitting and receiving image data via a public network (32) (i.e. the modem (59) is used for performing transmission and reception of facsimile communications between the public network (32) and the circuit controller (61). The circuit controller (61) is used for transmitting and responding to calls by the public network (32); see figs. 1 and 2; col. 3, lines 57-65 and col. 4, lines 1-60);

means for transmitting and receiving mail data via a network (31) (i.e. the mail controller (65) is used for converting facsimile data into e-mail data to be transmitted and converts e-mail data received; see figs. 1 and 2; col. 3, lines 57-65 and col. 4, lines 1-60);

subject name registration means for registering one or a plurality of subject names insertable into an electronic mail message for transmitting the mail data (i.e. in the title recording area (45d) the user can register desired titles in the facsimile device (1). The operation panel (55) is used to register addresses and other information, such as titles of emails; see figs. 1-3 and 5; col. 3, lines 57-65; col. 4, lines 1-60; col. 5, lines 28-67 and col. 6, lines 1-10);

subject name specification determination means for determining whether one of the subject names is specified for the mail data to be transmitted (i.e. in figure 7, both steps S410 and S320 determine if whether a title registered is specified to be the title of an e-mail that will be transmitted. Although a specific subject name specification determination means is not specifically disclosed, the feature is clearly performed by the system; see fig. 7; col. 6, lines 58-66 and col. 7, lines 1-26); and

subject name specifying means for automatically specifying one of the subject names registered in said subject name registration means as a transmission subject name of the mail data if said subject name specification determination means determines that none of the subject names is specified for the mail data (i.e. in the system of Tomida '255, the system waits for a user to input a title that will be attached to an e-mail. If the user inputs a title because of the prompt, the input title is input, but if the user ignores the prompt, the system forcefully sets a title in the e-mail. The forcefully set title comes from the default titles stored in the default title area (45e). Although a specific subject name specifying means is not specifically disclosed, the feature is clearly performed by the invention of Tomida '255; see fig. 10; col. 8, lines 53-66 and col. 9, lines 1-22).

Re claim 2: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, wherein said subject name specifying means specifies a specific one of the subject names registered in said subject name registration means as the transmission subject name (i.e. when the

system selects, or specifies, a specific title name to be transmitted as the title of an email, the system refers to the list in the recording area (45d) to display a list of titles the user can choose from in relation to the one-touch keys; see fig. 7; col. 6, lines 58-66 and col. 7, lines 1-26).

Re claim 3: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, further comprising means for causing one of the subject names registered in said subject name registration means to be specified as the transmission subject name (i.e. when the user chooses the desired title to be used as a title of an email, this title is transmitted with the rest of the email data to the email address also selected; see fig. 7; col. 6, lines 58-66 and col. 7, lines 1-26).

Re claim 4: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, wherein said subject name specifying means successively specifies the subject names registered in said subject name registration means as the transmission subject name in accordance with specified priorities of the registered subject names (i.e. when user prompted to enter in a title, the user's input is given priority over the title forcefully inputted into the email data. This is an example of the title chosen by the user given higher priority over the title automatically added to the email to be transmitted and the higher priority title given

preference of being input into the email unless the higher priority is not chosen; see fig. 10; col. 8, lines 53-66 and col. 9, lines 1-22).

Re claim 5: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine as claimed in claim 1, wherein said subject name registration means is adapted to be able to register the subject name by an identification code, the identification code being characteristic of an individual user (i.e. the one-touch keys can be analogous to the identification code since the keys are characteristic of a record of a individual user who is a receiving party of an email or a facsimile transmission. The one-touch keys can be used to register the titles that are used frequently in the system; see figs. 4 and 5; col. 5, lines 1-67 and col. 6, lines 1-24).

Re claim 6: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, further comprising:

code specification determination means for determining whether the identification code is specified (i.e. in the system, the one-touch keys are detected to selected, or specified, since a one-touch key has to be selected before a title or a user name is entered in correspondence to the one-touch key. Although a code specification determination means is not specifically disclosed, the function of determining if a identification code, analogous to a one-touch key, is specified is performed by detecting when a one-touch key is pressed; figs. 4-7; col. 5, lines 1-67; col. 6, lines 1-66 and col. 7, lines 1-34); and

subject name registration determination means for determining whether the subject names are registered for the identification code determined by said code specification determination means to be specified (i.e. when the user utilizes the one-touch method for selecting a desired title, the system makes a determination of the titles that correspond with the one-touch keys selected. The titles in relation to one-touch keys are displayed to the user for choosing; see fig. 7; col. 7, lines 1-26),

wherein said subject name specification means employ, as the transmission subject name, one of the subject names determined by said subject name registration determination means to be registered (i.e. the titles displayed to the user that are determined to belong to the associated one-touch key are registered in the title recording area (45d). This title is used in the email transmitted to another party; see fig. 7; col. 7, lines 1-26).

Re claim 7: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, further comprising address registration determination means for determining whether a mail address is registered for the identification code as an address to which the mail data is transmitted (i.e. the one-touch keys, considered as the identification code, are used to register email addresses of receiving devices. The system determines what email addresses are registered to the one-touch keys. Although a registration determination means is not specifically disclosed, the feature of determining an email address is registered for an identification code, analogous to a one-touch key, as an address to transmit an email is

performed; see fig. 4 and 6; col. 5, lines 1-67 and col. 6, lines 1-66 and col. 7, lines 1-26),

wherein said subject name specifying means specifies the mail address registered for the identification code as the transmission subject name when the subject name specification determination means determines that the subject names are not registered for the mail data (i.e. in figure 4, a name and an email address is associated with the one-touch keys, which is considered as the identification codes. The one-touch key has a mail address being registered as the address used for transmitting an email to another facsimile device. This email address is designated, or specified, by the user. This feature occurs when the actual subject names, or email address, in this scenario are not registered and the user is asked in step 100 if the user would like to register the chosen email address with the one-touch key. Also, since the mail address can be used as a transmission subject name because any title of any kind can be used, the above feature is performed. Therefore, the feature of specifying a mail address registered for the identification code as a transmission subject name when the subject name is determined to not be registered for the mail data is performed; see fig. 4; col. 4, lines 57-66 and col. 5, lines 1-27),

said code specification determination means determines that the identification code is specified (i.e. in the system, the one-touch keys are detected to selected, or specified, since a one-touch key has to be selected before a title or a user name is entered in correspondence to the one-touch key. Although a code specification determination means is not specifically disclosed, the function of determining if a

identification code, analogous to a one-touch key, is specified is performed by detecting when a one-touch key is pressed; figs. 4-7; col. 5, lines 1-67; col. 6, lines 1-66; col. 7, lines 1-34 and col. 9, lines 1-31), and

said address registration determination means determines that the mail address is registered for the identification code (i.e. in the facsimile transmission routine shown in figure 6, when one of the one-touch keys are displayed and selected, in step 230, an address is determined to be specified in correspondence with the one-touch keys. Once the address is registered, or stored, in correspondence with the one-touch keys, the system displays the address to the user of the address when a one-touch key is selected and a destination related to the one-touch key is specified. The feature of determining if the mail address is registered, or stored, in relation to the one-touch keys, or the identification code, is performed; see fig. 4-6; col. 4, lines 57-66 and col. 5, lines 1-67 and col. 6, lines 1-57).

Re claim 8: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, further comprising user code name registration determination means for determining whether a user code name is registered for the identification code as an address to which the mail data is transmitted (i.e. shown in figure 4, a name, considered as a user code name, is determined to be registered in correspondence to a one-touch key. With the name of the receiving party, a mail address or a facsimile number must also be determined if registered in relation to the one-touch key, which is to be considered as the identification code. The email

address is the address in which the email will be transmitted. Therefore, the system determines if a name, considered as a user code name, is registered for a one-touch key, considered as an identification code, as an email address to which mail data is to be transmitted; see fig. 4; col. 4, lines 57-66 and col. 5, lines 1-27),

wherein said subject name specifying means specifies the user code name registered for the identification code as the transmission subject name when the subject name specification determination means determines that the subject names are not registered for the mail data (i.e. the name, considered as the user code name, is associated with an email address or a facsimile number in order to provide a receiving party a document communicated through fax or email. The name with an email or fax number are registered for the one-touch key and this process is performed when the destination data is determined to have no mail address or fax number associated with a name, to send to a receiving party. This same name can be used as a transmission subject name since any title of any kind can be used; see fig. 4; col. 4, lines 57-66; col. 5, lines 1-27 and col. 9, lines 1-31),

said code specification determination means determines that the identification code is specified (i.e. in the system, the one-touch keys are detected to selected, or specified, since a one-touch key has to be selected before a title or a user name is entered in correspondence to the one-touch key. Although a code specification determination means is not specifically disclosed, the function of determining if a identification code, analogous to a one-touch key, is specified is performed by detecting

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when a one-touch key is pressed; figs. 4-7; col. 5, lines 1-67; col. 6, lines 1-66 and col. 7, lines 1-34),

and said user code name registration determination means determines that the user code name is registered for the identification code (i.e. when the user wants to transmit information to a user, the user is shown the names of the receiving parties that the user can send information to. This information is displayed when the system determines the names, considered as the user code names, registered, or associated with, the one-touch keys, which are considered to be the identification codes. The system automatically determines the association of the names registered with the one-touch keys; see fig. 4-6; col. 4, lines 57-66 and col. 5, lines 1-67 and col. 6, lines 1-57).

Re claim 9: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, wherein said subject name specifying means specifies the transmission subject name using one of a facsimile number and a name of a transmitter of the mail data (i.e. shown in figure 4, the system specifies a facsimile number when the user is trying to fax a document and during the receiving routine of a facsimile, the transmitter of the mail data is shown in a sending report to the user; see figs. 4 and 8; col. 5, lines 1-67; col. 6, lines 1-57; col. 7, lines 1-66 and col. 8, lines 1-52).

Re claim 10: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, wherein said subject name specifying means specifies the transmission subject name using one of: in the order described, the subject name (i.e. the subject name can be considered the title and this can be used to specify the transmission subject name by being registered in relation to the receiving party. The title is first consider when trying to place a title on a transmitted fax or email; see fig. 5 and 7; col. 4, lines 45-51 and col. 5, lines 1-67 and col. 6, lines 1-66 and col. 7, lines 1-26); the mail address (i.e. the email address of a receiving party can be used as a transmission subject name since any input title can be used; see fig. 10; col. 9, lines 1-31); the user code name (i.e. the user code name, considered as the name of the receiving party, can be used since any kind of title input into the system can be used in the invention; see fig. 10; col. 9, lines 1-31); and the facsimile number or the name of the transmitter of the mail data registered for the identification code (i.e. the facsimile number or the transmitter of the mail data registered for the identification code, considered as the one-touch keys, can be used since any kind of title input into the system can be used; see fig. 10; col. 9, lines 1-31).

Re claim 11: The teachings of Tomida '255 are disclosed above.

Tomida '255 disclosed the network facsimile machine, further comprising means for displaying (57) the one of the subject names specified by said subject name specifying means on said display means (i.e. the LCD (57) displays messages and other information, such as the titles and the email addresses registered to the one-touch keys; see figs. 2 and 7; col. 4, lines 1-51; col. 6, lines 58-66 and col. 7, lines 1-34).

Re claim 12: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, further comprising editing means for editing, by an input operation, the one of the subject names displayed on said display means (i.e. the subject name, or title, used in the invention can be edited by being deleted or overwritten with a new title. This editing is performed by the operation panel (55); see figs. 5 and 10; col. 5, lines 28-67; col. 6, lines 1-10 and col. 9, lines 1-31).

Re claim 13: The teachings of Tomida '255 are disclosed above.

Tomida '255 discloses the network facsimile machine, wherein said editing means is adapted to be able to perform editing using the subject names registered in said subject name registration means (i.e. the editing occurs to the subject names, or titles, registered in the system in title recording area (45d). These titles are in registered in correspondence with the one-touch keys and the titles may be deleted or overwritten with a different title being presented. The different title may be a variation of the previous title, but may be still different; see figs. 5 and 10; col. 5, lines 28-67; col. 6, lines 1-10 and col. 9, lines 1-31).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Dickerson whose telephone number is (571)-270-1351. The examiner can normally be reached on Mon. thru Thur. 9:00-6:30 Fri. 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571)- 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CD/ LD
Chad Dickerson
June 13, 2007


AUNG S. MOE
SUPERVISORY PATENT EXAMINER
